

REMARKS

The Office Action dated February 19, 2009 has been reviewed and carefully considered. Claims 1-21 remain pending with claims 1, 11 and 21 being the only independent claims. Reconsideration of the above-identified application in view of the following remarks, is respectfully requested.

As an initial matter, applicant submits that the current office action is improperly designated "Final" as the examiner has introduced a new §101 ground of rejection that was not necessitated by any amendment in applicant's first office action response. Accordingly, applicant respectfully requests that the finality of the Office Action be removed so that he may be provided the opportunity to respond in a manner not restricted by the requirements of 37 C.F.R. §1,116.

Claim 21 stands rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention: "While the claims recite a series of steps or acts to be performed, a statutory 'process' under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing" (Office Action, page 2).

Claim 21 recites a graphical display for a personal recording device which comprises depicting a bar containing markers indicative of at least two program sections and a program pointer. It is unclear how such a device is outside of the permitted

statutory classes of 35 U.S.C. 101. In particular, Applicants submit that claim 21 meets the listed criteria (1) as it is tied to a particular apparatus (a display). That is, claim 21 does not perform some mathematical calculation and present it on a display device in a manner that can be deemed mere postsolution activity. The display of program sections onto a device is the intent of the invention as claimed in claim 21. Accordingly, claim 21 is tied to such a statutory display device, and is patentable under 35 U.S.C. §101.

Claims 1, 3 and 7-11, 13, and 17-21 stand rejected under 35 USC 103(a) as being unpatentable over Goto et al., U.S. Patent No. 7,218,837 (Hereinafter, “Goto”) in view of West et al., U.S. Pub. 2003/0110514 (Hereinafter, “West”). Claims 1 and 2 stand rejected under 35 USC 103(a) as being obvious over Goto in view of Eldering et al., U.S. Pub. 2007/0240181. Claims 4, 6, 14 and 16 stand rejected under 35 USC 103(a) as being obvious over Goto and West in view of Plourde, Jr. et al., U.S. Patent No. 7,218,839. Claims 5 and 15 stand rejected under 35 USC 103(a) as being obvious over Goto and West in view of Needham et al., U.S. Pub 2003/0177495. Applicants respectfully disagree.

The present invention relates generally to personal video recording devices, and more particularly, to a personal recording device that generates a graphical representation of programs being stored. Moreover, this graphical representation depicts program sections defined by markers. In particular, claim 1 recites:

1. A method of displaying a video signal, comprising the steps of:
retrieving the video signal;

generating a graphical display including a bar extending in a predetermined direction and divided into at least two program sections, the sections defined by markers, wherein at least one of the markers is capable of indicating when a user changes a channel prior to conclusion of a program; inserting the graphical display into the video signal; and outputting the video signal.

As recited in claim 1, the markers are capable of indicating channel changes by a user that occur prior to conclusion of a program. Support for this feature is found, *inter alia*, in paragraphs [0036] and [0037] of the application as published. The latter paragraph recites several alternative rules for when the markers are inserted during such changes. One such rule, that the user stay on the new channel for a minimum amount of time before a marker is set, forms support for the feature of amended claim 2 that the defined segment may be less than 120 seconds.

Goto fails to teach incorporating marking of program segments resulting from “channel surfing” by a user. The previous Office Action (dated August 21, 2008; and hereinafter referred to as the “2008 Office Action”) pointed to Col. 28 line 47 - Col. 29 line 14 and Fig. 8 as teaching this marker feature. These sections merely show a time line in which programs are depicted on a time bar as commencing at uniform time segments: “Recipe” at 11:30 and “News” at 12:00. Moreover, many features of Goto require such defined time slots. By way of example, and as contained in the section of Goto cited by the 2008 Office Action:

With reference to FIG. 8, the present time is between 1200 hours and 1230 hours (between 12:00 and 12:30). In the case where a head-retrieval command signal is inputted once via the key input unit 112 during the cache-ON recording mode of operation of the apparatus, one is selected from the predetermined time points which immediately precedes the present time. Since the present time is between 1200 hours and 1230 hours, the selected predetermined time point is 1200 hours (12:30). The portion of the cached program signal which temporally follows 1200 hours starts to be played back. Thus, the cached program portion related to news starts to be played back from its head. When a head-retrieval command signal is inputted twice in quick succession, one is selected from the predetermined time points which second immediately precedes the present time. The selected predetermined time point is 1130 hours. The portion of the cached program signal which temporally follows 1130 hours starts to be played back. Thus, the cached program portion related to a recipe starts to be played back from its head.

Such features of Goto require such defined time slots. In the response to the 2008 Office Action, applicant argued that Goto teaches away from displaying program segments defined by markers which correspond to channel changes that occur in the middle of a program – as recited in claim 1.

In the current Office Action, the examiner has attempted to remedy this deficiency in the teachings of Goto by combining Goto with West. In particular, the examiner points to paragraphs [0109], [0111] - [0112], and Figs. 11A-B, and 12-15 of West “which displays a surfed channel that user [sic] recently watched” (1st paragraph, page 7 of the current Office Action). Assuming, *arguendo*, that West teaches these features; as noted above, Goto teaches away from their use. Accordingly, such a combination of Goto and West is improper.

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

Applicants submit that the combination of Goto and West is improper as Goto teaches away from such a combination. Consequently, the second criterion, the expectation of success, is not met. As acknowledged in the current Office Action, Goto fails to disclose the features of claim 1 of “generating a graphical display including a bar extending in a predetermined direction and divided into at least two program sections, the sections defined by markers, wherein at least one of the markers is capable of indicating when a user changes a channel prior to conclusion of a program.” The improper combination of Goto with West fails to render these claim features as obvious over the prior art. Claim 11 and claim 21 also contain this segment marker feature and are deemed patentable over the prior art for at least the same reasons.

Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of claims 1, 11 and 21.

With regard to claims 2-10 and 12-20, these claims ultimately depend from one of the independent claims, which have been shown to be not obvious and allowable in view of the cited references. Accordingly, claims 2-10 and 12-20 are also allowable by virtue of their dependence from an allowable base claim. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

Dan Piotrowski
Registration No. 42,079

A handwritten signature in black ink, appearing to read "Thomas Onka", is written over a horizontal line.

By: Thomas Onka
Attorney for Applicant
Registration No. 42,053

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Mail all correspondence to:
Dan Piotrowski, Registration No. 42,079
US PHILIPS CORPORATION
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9624
Fax: (914) 332-0615